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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
PATENT EXAMINING OPERATION

First Named Inventor: Venkatram P. SHASTRI

Serial No: 10/668,484

Group Art Unit: 1641

Filed: 09/22/2003

Examiner: David L Vanik

Att. Docket No.: T1118-20071

Confirmation No.: 2930

For: ENGINEERING OF MATERIAL SURFACES

PROVISIONAL ELECTION IN RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop AMENDMENT  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to restriction requirement set forth in the September 16, 2005 Office Action, the time for responding thereto being extended in accordance with a Petition for Extension of Time submitted herewith, Applicants provisionally elect Group I (claims 1-31).

This provisional election is made with traverse.

A restriction requirement between inventions is proper only where there is a serious burden on the Patent Office to examine all of the claims in a single application, even when it appears that appropriate reasons exist for a restriction requirement. MPEP §803. Applicants respectfully submit that there would be no serious burden on the Patent Office to examine together at least claims 1-31 (Group I) and claims 40-50 (Group III) of the present claims because the subject matter of Groups I and III is sufficiently related that a search of any one group would encompass a search for the subject matter of the remaining group. In particular, both Groups I and III are classified in the same class 424, subclass 422. Thus, the restriction requirement is improper and should not be maintained.

Accordingly, reconsideration and withdrawal of the restriction requirement are respectfully requested.

Application No. 10/668,484  
Amendment Dated 11/7/2005  
Reply to Office Action of September 16, 2005

In response to the species election requirement set forth in the Office Action, Applicants hereby provisionally elect the following species for prosecution on the merits:

11(a) a metal as a particular species of "a surface" as recited in claim 7. Claims readable thereupon include claims 1-7, and 13-31.

12(b) an oxide as a particular species of "a structure" as recited in claim 22. Claims readable thereupon include claims 1-20, 22, 25-31.

13(a) a chemical functional group as a particular species of "a functional group" as recited in claim 26. Claims readable thereupon include claims 1-27.

This provisional election is made without traverse. Presently, claim 1 is generic with respect to the species election.

Applicants reserve their rights under 35 USC § 121 to file a divisional application for the non-elected claims.

Should the Examiner believe that anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,

CAESAR, RIVISE, BERNSTEIN,  
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November 7, 2005

Please charge or credit our  
Account No. 03-0075 as necessary  
to effect entry and/or ensure  
consideration of this submission.